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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
937-1499	

Application Number	Filed
10/656,527	September 5, 2003

First Named Inventor: WALDROP

Art Unit	Examiner
1746	Carrillo

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

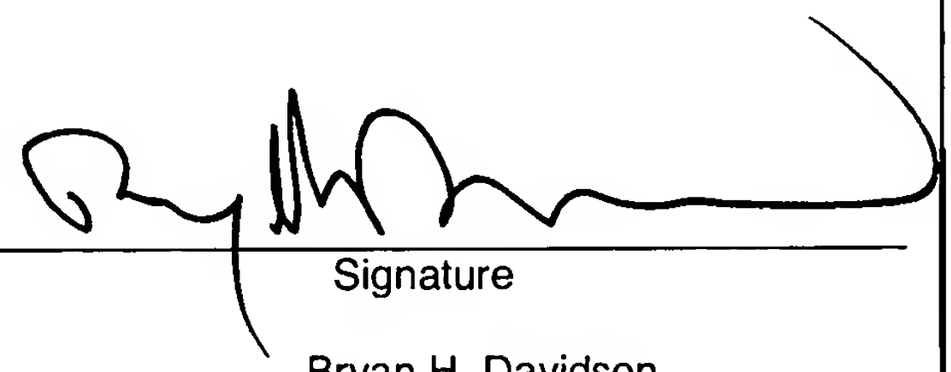
I am the

☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

☒ Attorney or agent of record 30,251 (Reg. No.)

☐ Attorney or agent acting under 37CFR 1.34.
Registration number if acting under 37 C.F.R. § 1,34 _____



Signature

Bryan H. Davidson

Typed or printed name

703-816-4026

Requester's telephone number

October 31, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

WALDROP et al Atty. Ref.: **937-1499**

Serial No. **10/656,527** Group: **1746**

Filed: **September 5, 2003** Examiner: **Carrillo**

For: **METHOD OF REMOVING COATINGS FROM PLASTIC ARTICLES**

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October 31, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ARGUMENTS SUPPORTING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

The following arguments are submitted in support of applicants' concurrently filed pre-appeal brief request for review.

I. The Examiner's Criticisms of the Rule 131 Evidence Of Record Are Legally Erroneous

In her Official Action dated July 20, 2006, the Examiner has withdrawn her prior rejections based on Fusiak in view of Sullivan and further in view of Lohr, and Leon et al. The Examiner has, however, maintained her rejections of all claims based principally on the combination of Fusiak, in view of Sullivan and further in view of Machac, Jr. et al.

By way of recollection, the Rule 131 Declaration filed with the Amendment of May 4, 2006 provided evidence of invention prior to the effective date of the applied Machac, Jr. et al publication – that is, prior to April 26, 2001. The antedating evidence

provided in the Rule 131 Declaration showed the paint stripping efficacy of a 90% NMP/10% HCl solution using 25 kHz ultrasonic energy.

The Examiner now complains in her July 20, 2006 Official Action that the Rule 131 Declaration "...is not commensurate with the scope of the claims." Particularly, the Examiner criticizes the proffered evidence since no species of pyrrolidone other than NMP were employed. In addition, the Examiner criticizes the proffered evidence since the claims do not recite 25 kHz or HCl as a pH adjuster. The Examiner's rationale in this regard is legally erroneous.

Specifically, applicants note that it is a well established principal that a reference applied against generic claims may be antedated under Rule 131 by showing completion of the invention of ***only a single species within the genus*** prior to the effective date of the reference. *Ex parte Biesecker,* 144 USPQ 129 (Bd. App. 1964). Moreover, the Examiner has acknowledged that the applied Machac, Jr. et al reference does in fact teach the use of NMP.[1] As such, the proffered evidence shows prior invention of a species which is in fact disclosed in Machac, Jr. et al.

The criticism with respect to the claims not reciting specifically that the ultrasonic energy was 25 kHz or that HCl was used as the pH adjuster is likewise erroneous. Thus, once again the proffered evidence established that species within the genus of "ultrasonic energy" and the genus of "pH adjuster", respectively, were in fact possessed by the present applicants' prior to the reference date of Machac, Jr. et al – i.e., prior to April 26, 2001.

Hence, continued rejection on the basis of Machac, Jr. et al in view of the evidence of record in the subject application amounts to reversible error.

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[1] "Machac Jr. et al. teach stripping paint from automotive body parts using NMP (paragraphs 2 and 12)..." Official Action dated July 20, 2006 at page 3, lines 17-18.

II. The Examiner's Rejections Are Per Se Erroneous

Applicants also that, in responding to the applicants' prior arguments on page 8, lines 11—14, the Examiner has somewhat tangentially referenced the Bivins et al, Muraoka et al and Freij (newly cited) as providing examples of the art notoriety with respect to using ultrasonics to enhance contaminants and/or paint removal. However, the Examiner has not actually applied such references in her claim rejections. In any event, the present applicants are not claiming to be the first inventors of using ultrasonics generally to remove paint. Thus, if the Examiner intends to assert that these references somehow affect the statutory patentability of the claimed invention, she should say so and advance a specific rejection based on such references to which the applicants can then respond. This she has not done and thus if such references are needed in order to statutorily reject the pending claims herein, then the rejections as stated in the July 20, 2006 Official Action are per se erroneous.

III. Conclusions

Withdrawal of all rejections of record are in order and such favorable action is solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____
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